REMARKS

In view of the following remarks, reconsideration of the rejections and objections, and further examination are requested.

Claims 1 and 3-17 are pending in this application and stand rejected. Claims 1, 4, 8, 9, 11 and 15 are amended herein. No new matter has been added.

The Amendment filed on January 31, 2008 also included an amendment to paragraph [0075] to correct a typographical error. Specifically, lines 3-4 of paragraph [0075] were amended to describe that ". . . it would ~~not~~ be impossible to identify each of the vital data of a particular patient." Thus, lines 3-4 were amended to remove the word "not." Please note that the original Japanese specification does not include this typographical error, so the error appears to be from translating the Japanese specification into English.

The amendment filed on January 31, 2008 has been objected to on the basis that it introduces new matter into the disclosure. Specifically, the Examiner asserted that the recitation *"correspondence between each of the unique identification and patient data including at least a patient name is unrecognizable,"* appears to constitute new matter. Moreover, claims 1, 8 and 9 have been rejected under 35 USC § 112, first paragraph, on the basis that they fail to comply with the written description requirement. Specifically, the Examiner asserted that *"correspondence between each of the unique identification and patient data including at least a patient name is unrecognizable,"* is not described in the Applicants' specification.

The Applicants respectfully submit that this recitation does not constitute new matter because adequate support can be found in the specification in paragraphs [0074] and [0075]. Specifically, paragraph [0075] describes in lines 1-3 that "although the patient server 1 stores the vital data for each of the IDs, the patient server 1 does not store the patient data corresponding to each of the IDs." As a result, it is impossible to identify each of the vital data with a particular patient (see lines 3-6 of para. [0075]). Thus, because the patient data is not stored in the patient server, the correspondence between each of the unique identifications and patient data cannot be determined, and as a result one of ordinary skill in the art would understand that the "the correspondence . . . is unrecognizable."

The Examiner also asserted that the specification does not provide support for a "patient name is unrecognizable." However, as recited in the claims, it is the correspondence which is unrecognizable, not the patient name. To clarify this feature of the invention, the Applicants have amended claims 1, 8 and 9 to recite that ". . . correspondence between each of the unique identifications and patient data, <u>wherein the patient data includes at least a patient name</u>, is unrecognizable." Paragraph [0074] describes the patient data including information for identifying a particular patient, such as name. Thus, the Applicants submit that one of ordinary skill in the art would understand paragraph [0074] to provide adequate support for <u>the patient data includes at least a patient name</u>, as recited in claims 1, 8 and 9.

Accordingly, the Applicants respectfully request that the objection to the amendment filed on January 31, 2008 on the basis that it introduces new matter into the disclosure, and that the 35 USC § 112 first paragraph rejection of claims 1, 8 and 9 be withdrawn.

Claim 1 has been rejected under 35 USC § 112, second paragraph, on the basis that it is indefinite. Specifically, the Examiner asserted that in the 6/18/07 Amendment claim 1 recited that the vital information **is not** associated with a corresponding unique identification, while in the 1/31/08 Amendment claim 1 recited that the vital information **is** associated with a corresponding unique identification. Moreover, the Examiner indicated that claim 1 has been interpreted as reciting that the vital information **is** associated with a corresponding unique identification.

Amended claim 1 recites storing and managing received vital information and unique identifications in a first database such that *the vital information **is** associated with a corresponding unique identification*, and such that correspondence between each of the unique identifications and patient data, wherein the patient data includes at least a patient name, is unrecognizable. Thus, the Applicants respectfully submit that claim 1 is definite.

Accordingly, the Applicants respectfully request that the 35 USC § 112, second paragraph rejection of claim 1 be withdrawn.

Claims 1 and 3-17 are rejected under 35 USC § 103(a) as being unpatentable over Joao (U.S. Patent No. 6,283,761) in view of Felsher (U.S. Patent Application Publication No. 2002/0010679).

Claims 1, 8 and 9 have been amended to more particularly recite the features recited therein. Support for these claim amendments may be found throughout the specification, and particularly, in paragraphs [0074] and [0075] as discussed above.

On page 14 of the Office Action, the Examiner indicated that "If the prior art structure is capable of performing the intended use, then it meets the claim." Consequently, the Applicants have also amended claims 1, 4, 8, 9, 11 and 15 to more positively recite the functions recited in the claims. For example, "operable to receive . . . store . . . manage . . . and transmit," as previously recited in claim 1 has been amended to "receiving . . . storing . . . managing . . . and transmitting," respectively.

Thus, the above mentioned rejections are submitted to be inapplicable to the amended claims for the following reasons.

Claim 1 is patentable over the combination of Joao and Felsher because claim 1 recites a medical information system including, in part, a patient server including a first database, the patient server receiving vital information and unique identifications allocated to patients, storing and managing the received vital information and unique identifications in the first database such that the vital information is associated with a corresponding unique identification and such that correspondence between each of the unique identifications and patient data, wherein the patient data includes at least a patient name, is unrecognizable, and transmitting the stored and managed vital information and unique identifications. Moreover, the medical information system of claim 1 includes a first network configured to allow communication between the patient server and a medical care provider server and disallow communication between either a patient terminal or a doctor terminal and either the patient server or the medical care provider server, and disallow communication between the patient terminal and the doctor terminal. Furthermore, the medical information system of claim 1 includes a second network configured to allow communication between the patient terminal and the patient server, and disallow communication among the patient server, the medical care provider server, and the doctor terminal, and a third network configured to allow communication between

the doctor terminal and the medical care provider server, and disallow communication among the patient server, the medical care provider server, and the patient terminal.

In contrast, Joao discloses a medical information system including a server 10 that acts as a connection node for a health care provider device 20, a payer device 30, a patient device 40, and an intermediary device 50. The provider device 20, the payer device 30, the patient device 40, and/or intermediary device 50, can be any computer or communication device, including, but not limited to, a personal computer, a home computer, a server computer, a network computer, a hand held computer and the like. Server 10, provider device 20, payer device 30, patient device 40, and intermediary device 50, can transmit information to, as well as receive information from, any of the other devices 10, 20, 30, 40, and 50. Each of the devices 10, 20, 30, 40 and 50 can be linked with any other computer or computers directly or indirectly directly or indirectly with one another so as to facilitate direct or indirect bidirectional communication.

Server 10 of Joao includes a database 10H that contains any and/or all of the information needed and/or required in order to perform any and/or all of the functions, services and/or operations for the invention of Joao. Database 10H contains data and/or information regarding patient name, patient identification information, patient social security number or other identification information, data of birth, doctors or providers and so on. The data and/or information which is or which may be stored in the database 10H, can be utilized and/or can appear in any of the reports, diagnostic reports, treatment reports, evaluation reports, provider reports, payer reports, patient reports, training reports, and/or any reports of Joao. The provider device 20, the payer device 30, the patient device 40 and the intermediary device 50, each contain, respectively, databases 20H, 30H, 40H, and 50H. Each of these databases can contain and/or be linked to any of the data and/or information described as being stored in the database 10H.

While using the system of Joao, a user can enter information concerning the patient, the treatment, and or care, which is desired to be evaluated and or monitored. Server 10 uses database 10H to obtain patient information, patient medical history, family history, if pertinent, system information, provider information, and/or any other information which can be relevant and or pertinent.

Based on the above discussion, it is apparent that the medical information system of Joao includes devices 10, 20, 30, 40 and 50 that can be linked with any other computer or computers directly or indirectly with one another so as to facilitate direct or indirect bidirectional communication. Moreover, the medical information system of Joao stores information regarding patient identifications and associates these patient identifications with corresponding patient medical history. Furthermore, there is no disclosure or suggestion in Joao that communication between the devices 10, 20, 30, 40 and 50 is limited to any communication channel(s) or direction, and that at least one of the computer devices 10, 20, 30, 40, and 50 stores and manages vital information that is associated with a corresponding unique identification such that a correspondence between the unique identifications and patient data is unrecognizable.

In other words, the system of Joao <u>does not</u> disclose a system including a patient server having a first database, where the patient server receives vital information and unique identifications *allocated to patients*, stores and manages the received vital information and unique identifications in the first database such that the vital information is associated with a corresponding unique identification and *such that <u>correspondence between each of the unique identifications and patient data, wherein the patient data includes at least a patient name, is unrecognizable</u>*, and transmits the stored and managed vital information and unique identifications. Moreover, the system of Joao<u> does not</u> disclose *a first network configured to allow communication between the patient server and a medical care provider server and disallow communication between either a patient terminal or a doctor terminal and either the patient server or the medical care provider server, and disallow communication between the patient terminal and the doctor terminal*. Furthermore, the system of Joao <u>does not</u> include *a second network configured to allow communication between the patient terminal and the patient server, and disallow communication among the patient server, the medical care provider server, and the doctor terminal*. The system of Joao also <u>does not</u> include *a third network configured to allow communication between the doctor terminal and the medical care provider server, and disallow communication among the patient server, the medical care provider server, and the patient terminal*. Therefore, Felsher must disclose or suggest these features in

order for the combination of Joao and Felsher to render the present invention as recited in claim 1 obvious.

Regarding Felsher, it is relied upon in the rejection as disclosing second and third networks. Specifically, Felsher discloses a system of maintaining the security of medical records against unauthorized access or use including a medical information database 6 for storing patient medical records which may be encrypted or unencrypted. During operation, encrypted files are received and stored in conjunction with an index server 5 in the database 6. An index record is provided in the index server 5 for each database 6 entry, providing an identification for the patient, a locator for the associated record, and a set of access rules for the record. The patient records are intrinsically anonymous, and thus are identified only by association with the respective patient through index 5. Thus, database 6 maintains patient medical history records separate from corresponding patient identification information contained in the index server 5. Moreover, the patient records, albeit without the patient personally identifying information, may be used for anonymous summary information searches.

Furthermore, the system of Felsher uses the internet as a preferred communications network. Thus the records may be transmitted virtually anywhere on earth using a single infrastructure. Alternately, private networks or virtual private networks may be employed.

Thus, it is clear that Felsher also fails to disclose or suggest the above-discussed features of the medical information system of claim 1.

It is respectfully submitted that the cited art, as a whole, is not suggestive of the presently claimed invention. Specifically, Applicants respectfully submit that <u>Felsher teaches away from Joao</u>, and as such, supports the non-obviousness of the invention. More specifically, in contrast to Joao, Felsher clearly describes a medical security system including a database 6 that maintains patient medical history records separate from corresponding patient identification information contained in the index server 5.

By virtue of maintaining the database 6 separate from the index server 5, <u>Felsher teaches against associating patient medical records with the corresponding unique identification</u>. Moreover, because Felsher does not also employ a system that maintains patient medical history that is associated with corresponding unique identification

information in a same database, it is incompatible with Joao. Substituting the medical security system of Felsher for the health care information system of Joao, renders the system of Joao unsatisfactory for its intended purpose because a user cannot then access a patient's medical history and/or other information that can be relevant and/or pertinent using corresponding unique identifications. Because the proposed modification/substitution changes the principle of operation of Joao and renders Joao unsatisfactory for its intended purpose, Felsher is incompatible with Joao. Thus, considering the references as a whole, there is no reason to make the proposed combination of references. As a result, claim 1 is patentable over the combination of Joao and Felsher.

In the May 28, 2008 Office Action, the Examiner does not appeared to have seriously considered the Applicants' argument regarding the combination of Joao and Felsher because the Examiner did not address the merits of the Applicants' arguments. Instead, the Examiner merely repeated text from the September 6, 2008 Office Action stating that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found in either the references themselves or in the knowledge generally available to one of ordinary skill in the art. Moreover, the Examiner merely repeated that it would have been obvious to combine the teachings of Felsher with the teachings of Joao with the motivation of providing a secure system for exchanging confidential information. The Applicants again respectfully traverse this assertion.

As discussed in the January 31, 2008 Amendment, MPEP § 2145(III) establishes that a claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose, and MPEP § 2145(VI) establishes that a prior art reference must be considered in its entirety. The Applicants respectfully submit that, although Felsher is in the same field of endeavor as Joao, the Examiner has not considered Felsher in its entirety. Specifically, it does not appear that the Examiner has considered how maintaining the database 6 separate from the index server 5, teaches against associating patient medical records with the corresponding unique identification. Thus, as discussed above, when Felsher is

considered in its entirety, it teaches away from Joao because it changes the principle of operation of Joao and renders Joao inoperable for its intended purpose.

Regarding claim 8, it is patentable over the references relied upon in the rejection for reasons similar to those set forth above in support of claim 1. That is, claim 8 recites a medical information system including, in part, a plurality of patients servers each including a first database where each patient server receives vital information and unique identifications *allocated to patients*, stores and manages the received vital information and unique identifications in a respective first database such that the vital information is associated with a corresponding unique identification, *and such that correspondence between each of the unique identifications and patient data, wherein the patient data includes at least a patient name, is unrecognizable*.

Moreover, the medical system of claim 8 includes *a first network configured to allow communication between the patient servers and a medical care provider server and disallow communication between either patient terminals or a doctor terminal and either the patient servers or the medical care provider server, and disallow communication between the patient terminals and the doctor terminal.*

Furthermore, the medical system of claim 8 includes *a second network configured to allow communication between the patient terminals and the patient servers, and disallow communication among the patient servers, the medical care provider server, and the doctor terminal.* The medical system of claim 8 also includes *a third network configured to allow communication between the doctor terminal and the medical care provider server, and disallow communication among the patient servers, the medical care provider server, and the patient terminals.*

Regarding claim 9, it is patentable over the references relied upon in the rejection for reasons similar to those set forth above in support of claim 1. That is, claim 9, recites a medical information system including, in part, a patient server comprising a first database, where the patient server receives vital information and unique identifications *allocated to patients*, stores and manages the received vital information and said unique identifications such that the vital information is associated with a corresponding unique identification and *such that correspondence between each of the unique identifications*

and patient data, wherein the patient data includes at least a patient name, is
unrecognizable.

Moreover, the medical information system of claim 9 includes *a first network*
configured to allow communication between the patient server and medical care provider
servers and disallow communication between either a patient terminal or doctor
terminals and either the patient server or the medical care provider servers, and disallow
communication between the patient terminal and the doctor terminals.

Furthermore, the medical system of claim 9 includes *a second network configured*
to allow communication between the patient terminal and the patient server, and disallow
communication among the patient server, the medical care provider servers, and the
doctor terminals. The medical information system of claim 9 also includes *a third*
network configured to allow communication between the doctor terminals and the
medical care provider servers, and disallow communication among the patient server,
the medical care provider servers, and the patient terminal.

Because of the above mentioned distinctions, it is believe clear that claims 1 and
3-17 are patentable over the references relied upon in the rejections. Furthermore, it is
submitted that the distinctions are such that the person having ordinary skill in the art at
the time of invention would have no reason to make any combination of the references of
record in such a manner as to result in, or otherwise render obvious, the present invention
as recited in claims 1 and 3-17. Therefore, it is submitted that claims 1 and 3-17 are
clearly allowable over the prior art of record.

In view of the foregoing amendments or remarks, all of the claims now active in
this application are believed to be in condition for allowance. Reconsideration and
favorable action are respectfully solicited.

Should the Examiner believe there are any remaining issues that must be resolved before this application can be passed to issue, it is respectfully requested that the Examiner contact the undersigned by telephone in order to resolve such issues.

Respectfully submitted,

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